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Date	May 8, 2006	Total Pages: 10
To:	U.S. Patent and Trademark Office	
Attn.:	Examiner Devon C. Kramer	
Facsimile No.:	571-273-8300	
From:	Matthew P. Dugan, Reg. No. 44,663	
Re:	Serial No. 10/601,448 filed June 23, 2003 Our Ref.: P03042US1A FIRZ 2 00143	

COMMENTS

Attached are:

Pre-Appeal Brief Request for Review
Reasons for Requesting Pre-Appeal Brief Review
Notice of Appeal
Credit Card Payment Form

Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket No.: P03042US1A FIRZ 2 00143
Application No.: 10/601,448	Filed: June 23, 2003
Title: SYSTEM AND METHOD FOR DETERMINING APPROPRIATE CONDITIONS FOR LEVELING A VEHICLE HAVING AN AIR SUSPENSION SYSTEM	
First Named Inventor: Holbrook, et al.	
Art Unit: 3683	Examiner: Devon C. Kramer

Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.
This request is being filed with a notice of appeal.
The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.
☐ assignee of record of the entire interest See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
☒ attorney or agent of record.
☐ attorney or agent acting under 37 CFR 1.34.

Respectfully submitted,
FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP

Date: May 8, 2006

Timothy E. Nauman, Reg. No. 32,283
Matthew P. Dugan, Reg. No. 44,663
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NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of forms are submitted.

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this Pre-Appeal Brief Request for Review and accompanying documents are being
☐ deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
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Express Mail Label No.:	Signature
Date: May 8, 2006	Printed Name: Iris E. Weber

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Holbrook, et al. TITLE: **SYSTEM AND METHOD FOR DETERMINING APPROPRIATE CONDITIONS FOR LEVELING A VEHICLE HAVING AN AIR SUSPENSION SYSTEM**

APPLICATION NO.: 10/601,448 FILED: June 23, 2003

EXAMINER: Devon C. Kramer ART UNIT: 3683

CONFIRMATION NO.: 9762 LAST OFFICE ACTION: March 9, 2006

ATTORNEY DOCKET NO.: P03042US1A
FIRZ 2 00143

REASON(S) FOR REQUESTING PRE-APPEAL BRIEF REVIEW
(ATTACHMENT TO FORM PTO/SB/33)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits the following reasons for requesting a pre-appeal brief review of the above-captioned matter.

REMARKS

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of March 9, 2006, and disagree with the rejections of the claims.

Present State of the Claims

Claims 24-27 and 29-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shono, et al. (U.S. Patent No. 6,298,292, hereinafter Shono) in view of Raad, et al. (U.S. Patent No. 5,430,647, hereinafter Raad). Additionally, Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Shono in view of Raad and further in view of Karnopp (U.S. Patent No. 5,346,242).

Background

On pages 7 and 8 of Amendment E, which was filed on December 28, 2005, Applicants presented a detailed discussion of the differences between the claimed subject matter and the prior art of record. This previously presented discussion is not repeated herein. However, the arguments presented below rely upon all of the remarks of record, including specific reference to this earlier presented discussion.

Arguments

For at least the following reasons, the Office Action has failed to present a proper *prima facie* rejection of the currently pending claims under 35 U.S.C. §103(a).

1. The references of record do not, alone or in combination, teach or suggest all of the claimed limitations.

To establish a prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03, citing In re Royka, 180 USPQ 580 (CCPA 1974).

The Office Action asserts that Shono teaches a hydraulic suspension system that includes performance of all of the method steps recited in the subject claims. The Office Action further asserts that Raad teaches an air suspension system and that it would have been obvious to have provided the method of Shono with an air suspension such as that in Raad.

Applicants respectfully submit, however, that Shono does not teach all of the method steps recited in the subject claims, as asserted in the Office Action, and that the deficiencies of Shono are not remedied by any of the other art of record.

More specifically, as has been discussed in detail in the previously presented paper (Amendment E), Shono utilizes a system and method that involve setting various operational flags (e.g., state flag SF, changing flag CF, and change start flag CS) during iterative program loops based upon a comparison of performance conditions of the vehicle. In short, Shono suspends an ongoing height change in one iteration of the program loop (see steps **318-322** of routine **300**) and then terminates or ends that height change routine in the next iteration of the program loop (see steps **324** of routine **300**). This results in a return to the main program (e.g., program **100**), which reacquires the performance conditions and performs start determining routine **188** (routine **200** in FIGURE 3) before any possible return to the vehicle height changing routine can occur. Said differently,

Shono ends a first leveling action in response to a performance condition, and then initiates another, different leveling action from scratch once the performance condition has abated. This is a significant departure from the claimed subject matter of the present application.

Based upon the foregoing as well as earlier presented discussion, it is respectfully submitted that Shono does not teach or suggest a method of operation as presently claimed, which involves discontinuing an ongoing leveling action, waiting until a performance condition is met, and continuing the earlier leveling action. Additionally, the art of record does not cure this deficiency. Accordingly, Applicants respectfully submit that for at least this reason, the *prima facie* rejection of the currently pending claims under 35 U.S.C. §103(a) is improper.

Also, Shono does not teach or suggest the use of a second, lower acceleration threshold value for determining conditions suitable for continuing the earlier initiated leveling action. This is clearly indicated in the second to last sentence on page 2 of the latest Office Action, which states that "Shono lacks the teaching of the second threshold value being less than the first threshold value." This deficiency of Shono is not remedied by the disclosure of any of the other art of record.

The Office Action asserts that since all of the method steps of the subject claims are recited in Shono, the general conditions of the claim are met. The Office Action then states that the use of a second threshold value is merely changing the time when the leveling device is operated. Such at timing change, it is asserted, is akin to discovering an optimum or workable range of operation, which involves only routine skill in the art.

As indicated above, however, the references of record must teach or suggest all of the claimed limitations. Since, the Office Action fails to identify any teaching or suggestion of this limitation, Applicants respectfully submit that the *prima facie* rejection of the currently pending claims under 35 U.S.C. §103(a) is improper.

2. There is no suggestion or motivation in the prior art for modifying the primary reference as stated in the Office Action.

There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings, as discussed in MPEP §2143 citing In re Vaeck, 20 USPQ2d 1483 (Fed. Cir. 1991).

Having concluded that Shono teaches all of the method steps of the claimed subject matter, the Office Action does not assert that any modifications thereto would have been obvious. However, based upon at least the foregoing discussion, Applicants respectfully submit that Shono does not teach all of such method steps and further assert that there is no suggestion or motivation in the art of record for modifying Shono to operate according to the claimed method steps.

Additionally, the Office Action, in referring to the use of the second threshold value, asserts toward the bottom of page 2 thereof that the subject matter of the present application is merely modifying the Shono reference to continue the leveling when it is ensured that the vehicle is not going to be encountering excessive acceleration. Therefore, the Office Action asserts (beginning at the top of page 3 thereof), it would have been obvious to have controlled the leveling device of Shono to allow leveling of the vehicle after the vehicle reaches a second pre-determined acceleration value which is less than the first pre-determined acceleration value to prevent prematurely leveling the vehicle during times when a vehicle is experiencing extreme changes in acceleration. The Office Action then further asserts that having established the general conditions of the claim, discovering the optimum or workable ranges involves only routine skill in the art.

However, the Office Action points to no suggestion or motivation for making the asserted modification to Shono. Rather, the Office Action merely states in a conclusory manner that such a modification would have been obvious to the skilled artisan.

3. The Office Action impermissibly relies upon hindsight reconstruction in forming the present rejection of the claimed subject matter.

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the pertinent art. In re Kahn, 78 USPQ2d 1329 (Fed. Cir. 2006) citing 35 U.S.C. §103(a). [Emphasis added.] When, however, an Office Action does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, it is inferred that the Office Action used hindsight to conclude that the invention was obvious. See In re Rouffett, 47 USPQ2d 1453.

Since there does not appear to be any teaching or suggestion in the art of record for making the proposed modifications to Shono, and the Office Action points to no such

language, it is respectfully submitted that Applicants' disclosure is impermissibly being used to formulate the present rejections.

Applicants respectfully submit that evidence of the use of such impermissible hindsight reconstruction is even present in the Office Action itself, which states that "applicant is merely modifying the Shono reference to continue the leveling when it is ensured that the vehicle is not going to be encountering excessive acceleration." In light of this statement, it is clear that the Examiner is trying to force the claims of the subject application to fit into the teaching of the cited reference, rather than applying a reference to the claimed subject matter. It is respectfully submitted that this further indicates that hindsight reasoning is being employed.

CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application are now in condition for allowance. In the event personal contact is considered advantageous to the disposition of this case, please telephone the below signed at the listed number.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

May 8, 2006
Date

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CERTIFICATE OF MAILING OR TRANSMISSION

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